REMARKS

This Amendment is submitted in response to the Office Action dated August 26, 2005, having a shortened statutory period set to expire November 26, 2005. The present amendment cancels Claims 53-57. Upon entry of the proposed cancellations, Claims 46-52 and 58-75 will now be pending.

Claim objections

In paragraph 2 of the present office action, the Examiner has indicated that certain claim sets, which have different elements in their base claims, but are essentially the same claims when combined with their respective base claims, are substantive duplicates. Applicants appreciate the notification of this matter, and thus now cancel Claims 53-57 to overcome this objection.

Rejections under 35 U.S.C. § 112

In paragraph 4 of the present office action, the Examiner has rejected Claims 46-57 under 35 U.S.C. 112, second paragraph, for failing to make clear "who or whom is permitting the software application from being run or forwarded." Applicants are unaware of any legal requirement to make such identifications, and believe that the claims particularly point out and distinctly claim the subject matter. Thus, these rejections are traversed.

Rejections Under 35 U.S.C. § 103

In paragraph 6 of the present Office Action, Claims 46-75 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Olkin, et al* (U.S. Patent No. 6,584,564 – "*Olkin*") in view of *Leonard, et al* (U.S. Patent No. 6,721,784 – "*Leonard*"). Applicants respectfully traverse these rejections.

Olkin teaches a method and system for sending and receiving secure e-mail (see *Olkin's* abstract, et al.). Similarly, *Leonard* teaches a method and system for causing e-mails to automatically expire (see *Leonard's* abstract, et al.). Neither cited prior art teaches or suggests sending an application program to a receiving computer as taught and claimed by the present application.

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With regards to exemplary Claim 58, the cited art does not teach or suggest "in response to determining that the e-mail was not saved by the receiving computer, discontinues an installation on the receiving computer of the appended software application program." The Examiner has taken "official notice of both the motive and modification necessary to have an applet discontinue installation if an application is not saved first/unsaved." Use of this type of rejection is in contravention to Section 2144.03 of the MPEP, since "in response to determining that the e-mail was not saved by the receiving computer, discontinues an installation on the receiving computer of the appended software application program" is not supported by evidentiary support in the record. Applicants therefore traverse this rejection, and respectfully request that the Examiner provide concrete evidence in the record or through a personal affidavit that "in response to determining that the e-mail was not saved by the receiving computer, discontinues an installation on the receiving computer of the appended software application program" is "well known" in the prior art.

With regards to exemplary Claim 59, the cited art does not teach or suggest "permitting the software application program to run only if a determination is made that the e-mail message with the appended software application program was received by the receiving computer from a pre-specified e-mail server." *Olkin* uses a security server 24 and an e-mail server 22 (Figure 1), but does not teach or suggest a pre-specified e-mail server as being prerequisite to running an attached application.

With regards to exemplary Claim 60, the cited art does not teach or suggest "permitting the software application program to run only if a determination is made that a disabling instruction has been incorporated into the e-mail message that prevents the e-mail message with the appended software application program from being forwarded." *Leonard* teaches that an e-mail can have a "Do Not Forward" option (Figure 5) and an e-mail self-destruction option (col. 6, lines 20-35). However, neither *Leonard* nor *Olkin* teach or suggest making a "Do Not Forward" option mandatory to be able to open an application attachment. The Examiner addresses this feature on Page 4 of the current office action, stating, in effect, that such as feature is desirable. Applicants agree. However, the cited art does not teach or suggest this feature.

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Rather, the cited art is directed to protecting e-mails by preventing their forwarding (*Leonard, Figure 5*), protecting streaming content by only webcasting it live, protecting streaming applications through the use of self-destruct embedded instructions in streaming executable files, and protecting non-streaming files with encryption keys (*Leonard, col. 3, lines 49-65*). As the record is devoid of a teaching or suggestion of the claimed features in Claim 60, Applicants respectfully request that the present rejection be withdrawn.

With regards to exemplary Claim 61, the cited art does not teach or suggest "enabling the appended software application program only if the received and decrypted serial number matches the stored serial number." *Olkin* teaches a means for encrypting e-mail (col. 6, line 12 – col. 7, line 7), but does not teach or suggest "enabling the appended software application program only if the received and decrypted serial number matches the stored serial number." Again, the Examiner takes "official notice of both the motive and modification necessary for having a local processor store its identifying information/serial number/machine identify in an encrypted registry as part of a validation/installation process," and cites Figure 5; col. 8, lines 40-45 and 60-67; and col. 10, lines 25 et seq. of *Olkin* as support for this notice. However, *Olkin*, and in particular the cited passages, do not teach or suggest "enabling the appended software application program only if the received and decrypted serial number matches the stored serial number." Rather, *Olkin* merely teaches relational databases for e-mail users (Figure 5 and col. 10, lines 25 et seq.), and the use of encryption for e-mail (col. 8, lines 40-45). The only mention of an application in *Olkin* is "software module 26 for receiving and decrypting the secure e-mail" (col. 6, lines 57-58). That is, there is no teaching or suggestion of "enabling the appended software application program only if the received and decrypted serial number matches the stored serial number," since the only application program mentioned is the e-mail program itself. As the record does not support the "common knowledge" alleged by the Examiner, Applicants traverse this rejection, and respectfully request that the Examiner provide concrete evidence in the record or through a personal affidavit that "enabling the appended software application program only if the received and decrypted serial number matches the stored serial number" is "well known" in the prior art.

With regards to exemplary Claim 63, the cited art does not teach or suggest "the appended software application program can be installed on the receiving computer only once." *Olkin* teaches that an e-mail can be read a limited number of times (col. 9, lines 32-36), but makes no suggestion about limiting how often the appended software can be installed on the computer.

CONCLUSION

As the cited prior art does not teach or suggest all of the presently claimed limitations, Applicants now respectfully request a Notice of Allowance for all pending claims.

If the Examiner believes that it would beneficial to move the present application to allowance, Applicants' undersigned legal representative would appreciate a telephone call to discuss any issues deemed relevant by the Examiner.

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0457.**

Respectfully submitted,

James E. Boice
Registration No. 44,545
DILLON & YUDELL LLP
8911 North Capital of Texas Highway
Suite 2110
Austin, Texas 78759
512.343.6116

ATTORNEY FOR APPLICANT(S)